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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/558,329	04/25/2000	Randolph A. Stern	STAN-09RE	9722

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EXAMINER
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JUSKA, CHERYL ANN

ART UNIT	PAPER NUMBER
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1794

MAIL DATE	DELIVERY MODE
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09/10/2009

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 09/558,329	<b>Applicant(s)</b> STERN ET AL.	
	<b>Examiner</b> Cheryl Juska	<b>Art Unit</b> 1794	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 17 March 2009.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-87 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-87 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                     | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

Art Unit: 1794

### **DETAILED ACTION**

1. In view of the Order Returning Undocketed Appeal mailed March 17, 2009,

**PROSECUTION IS HEREBY REOPENED.**

2. Specifically, the Board of Patent Appeals and Interferences has returned the application for the following reasons:

1.) requiring correction of all amended and new claims, to be in compliance with 37 CFR 1.173;

2.) requiring a corrected Claim Appendix in compliance with 37 C.F.R. § 1.173;

3.) requiring submission of a proper supplemental reissue declaration to overcome the rejection of all the reissue claims under 35 U.S.C. 251, as being based upon a defective reissue declaration ; and

4.) for such other action as may be appropriate.

3. Changes to the Final Office Action mailed May 2, 2006, made in accordance with the Board's Order, are highlighted in bold below.

4. To avoid abandonment of the application, appellant must exercise one of the following two options:

(1) file a reply under 37 CFR 1.111 (if this Office action is non-final) or a reply under 37 CFR 1.113 (if this Office action is final); or,

(2) initiate a new appeal by filing a notice of appeal under 37 CFR 41.31 followed by an appeal brief under 37 CFR 41.37. The previously paid notice of appeal fee and appeal brief fee can be applied to the new appeal. If, however, the appeal fees set forth in 37 CFR 41.20 have

Art Unit: 1794

been increased since they were previously paid, then appellant must pay the difference between the increased fees and the amount previously paid.

5. A Supervisory Patent Examiner (SPE) has approved of reopening prosecution by signing below:

/D. Lawrence Tarazano/

Supervisory Patent Examiner, Art Unit 1794

### *Reissue Applications*

6. The amendment filed February 6, 2006, proposes amendments to the claims that do not comply with 37 CFR 1.173(b), which sets forth the manner of making amendments in reissue applications. A supplemental paper correctly amending the reissue application is required.

7. In the event, applicant reinstates an appeal in response to this Office Action, the Claim Appendix should also include all markings pursuant to 37 CFR 1.173.

8. Claims 1-87 are rejected as being based upon a defective supplemental reissue declaration under 35 U.S.C. 251. Specifically, the amendments filed May 3, 2005 and February 6, 2006, are not accompanied by proper supplemental reissue declarations. Additionally, the declaration filed with the RCE of May 3, 2005, does not appear to be signed by all of the inventors. See 37 CFR 1.175(b)(1) and MPEP 1414.01 and 37 CFR 1.172.

### *Claim Rejections - 35 USC § 102*

Art Unit: 1794

9. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
10. Claims 65 and 67-69 stand rejected under 35 U.S.C. 102(b) as being anticipated by US Patent 4,026,129 issued to Sternlieb, as set forth in section 6 of the last Office Action (Non-Final Rejection mailed 08/05/05).
11. Claims 30-37 and 51-64 stand rejected under 35 U.S.C. 102(b) as being anticipated by US 4,181,514 issued to Lefkowitz et al., as set forth in section 7 of the last Office Action.
12. Claims 1, 3-9, 12, 14-20, 30, 32-38, 51, 53-56, 58, 59, 61-66, 68, and 69 stand rejected under 35 U.S.C. 102(b) as being anticipated by US 4,675,226 issued to Ott, as set forth in section 8 of the last Office Action.
13. Claims 30, 32-36, 39, 41, 42, 46-51, 53-56, 65, 68, 69, 80, 83, 84, 86, and 87 stand rejected under 35 U.S.C. 102(b) as being anticipated by US 5,356,402 issued to Gillies et al., as set forth in section 9 of the last Office Action.

***Claim Rejections - 35 USC § 103***

14. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
15. Claims 2, 10, 11, 13, 21, 22, 31, 52, 57, 60, and 67 stand rejected under 35 USC 103(a) as being unpatentable over the cited Ott patent, as set forth in section 11 of the last Office Action.
16. Claims 1, 3-9, 12, 14-20, 23, 26-29, 37, 38, 43, 58, 61-64, 66, 70, 71, 73, 74, 76-79, and 81 stand rejected under 35 U.S.C. 103(a) as being unpatentable over the cited Gillies patent in view of the cited Ott patent, as set forth in section 12 of the last Office Action.
17. Claims 10, 11, 21, 22, and 57 stand rejected under 35 U.S.C. 103(a) as being unpatentable over the cited Gillies patent in view of the cited Ott patent, as applied to claims 1, 12, and 51 above, as set forth in section 13 of the last Office Action.
18. Claim 25 stands rejected under 35 U.S.C. 103(a) as being unpatentable over the cited Gillies patent in view of the cited Ott patent, as applied to claim 23 above, and in further view of

Art Unit: 1794

the cited Lefkowitz patent and US 4,128,686 issued to Kyle et al., as set forth in section 14 of the last Office Action.

19. Claims 40 and 82 stand rejected under 35 U.S.C. 103(a) as being unpatentable over the cited Gillies patent in view of EP 261 904 issued to Taylor, as set forth in section 15 of the last Office Action.

20. Claims 24 and 72 stand rejected under 35 U.S.C. 103(a) as being unpatentable over the cited Gillies patent in view of the cited Ott patent, as applied to claims 23 and 70 above, and in further view of EP 261 904 issued to Taylor, as set forth in section 16 of the last Office Action.

21. Claims 31, 44, 45, 52, 67, and 85 stand rejected under 35 U.S.C. 103(a) as being unpatentable over the cited Gillies patent in view of the cited Sternlieb patent, as set forth in section 17 of the last Office Action.

22. Claims 2, 13, 59, 60, and 75 stand rejected under 35 U.S.C. 103(a) as being unpatentable over the cited Gillies patent in view of the cited Ott patent, as applied to claims 1, 12, 58, and 70 above, and in further view of the cited Sternlieb patent, as set forth in section 18 of the last Office Action.

23. Claims 1-23, 25-39, 41-71, 73-81, and 83-87 stand rejected under 35 U.S.C. 103(a) as being unpatentable over US 4,128,686 issued to Kyle et al. in view of the cited Gillies, Ott, and/or Sternlieb patents, as set forth in section 19 of the last Office Action.

24. Claims 24, 40, 72, and 82 stand rejected under 35 U.S.C. 103(a) as being unpatentable over the cited Kyle patent in view of the cited Gillies, Ott, and/or Sternlieb patents, as applied to claims 23, 39, 70, and 80 above, and in further view of the cited Taylor patent, as set forth in section 20 of the last Office Action.

### ***Response to Arguments***

25. Applicant's arguments filed with the Response of February 6, 2006, have been fully considered but they are not persuasive.

26. Applicant traverses the rejections by asserting "Examiner, *without making a rejection*, maintains the position that the newly added claim language "effectively continuous" and "not generally exposed,"...is too subjective to be relied upon for distinguishing the present invention

Art Unit: 1794

from the prior art.” (Response, page 20, 3<sup>rd</sup> paragraph, emphasis added). To the contrary, the examiner maintained the rejections of record. Because the rejection was based upon arguments previously presented, applicant’s attention was directed to the Examiner’s Answer filed March 15, 2005, page 26, 1<sup>st</sup> paragraph, which presented arguments for if the term “effectively continuous” was given weight in the claims. Additionally, the examiner reiterated said arguments in section 4 of the last Office Action. Furthermore, the examiner properly responded to applicant’s arguments individually with respect to each prior art reference. Hence, applicant’s assertion that the examiner did not make an actual rejection is unfounded.

27. Applicant also traverses the rejections by relying upon the Wright Declaration filed with said amendment (Response, pages 21-22). Said declaration asserts that the claim language of “effectively continuous” and “not generally exposed” provides a sufficient level of objectivity which can be relied upon for distinguishing the present invention from the prior art (Wright Declaration, page 3, section 10). Wright argues the teachings of the specification provide definiteness and a standard for one skilled in the art as to the scope of the “effectively continuous” nature of the yarn face.

In response, it is reiterated that the claim language in question is relative. In other words, the claim recites a relative, subjective description of the yarn face rather than an objective or quantitative description of what qualifies as “effectively continuous such that the corresponding web surface is not generally exposed at the associated yarn face.” The specification provides no further objective or quantitative guidance (e.g., stitch yarn deniers or diameters, stitch sizes, or stitch densities). A relative description cannot be relied upon for distinguishing the present invention from the prior art. The Wright Declaration does not overcome this argument.

Specifically, said Declaration is an opinion declaration rather than a declaration which presents objective evidence. While opinion declarations are entitled to consideration and some weight so long as the opinion is not on the ultimate legal conclusion at issue, in assessing the probative value of an expert opinion, the examiner must consider the nature of the matter sought to be established, the strength of any opposing evidence, the interest of the expert in the outcome of the case, and the presence or absence of factual support for the expert’s opinion. MPEP 716.01(d). It is the examiner’s opinion that the absence of factual support for the expert’s opinion does not outweigh the strength of the obviousness rejection. Although an affidavit or

Art Unit: 1794

declaration which states only conclusions may have some probative value, such an affidavit or declaration may have little weight when considered in light of all the evidence of record in the application. *In re Brandstadter*, 484 F.2d 1395, 179 USPQ 286 (CCPA 1973). In view of the foregoing, when all of the evidence is considered, the totality of the rebuttal evidence of nonobviousness fails to outweigh the evidence of obviousness.

28. Additionally, while the declaration may assert the claim language is definite and a standard is provided for one of ordinary skill in the art to determine the scope of the claimed invention, it is noted that the rejection at hand is a 103 obviousness rejection. “When relative terms are used in claims wherein the improvement over the prior art rests entirely upon size or weight of an element in a combination of elements, the adequacy of the disclosure of a standard is of greater criticality.” MPEP 2173.05(b). As previously noted, the disclosure of the present application does not provide a sufficient standard for the relative claim language. Such a standard is critical when the only difference between the prior art and the present invention is one of degrees (i.e., relative terminology). Said declaration does not add any evidence to support the adequacy of said disclosure.

29. It is the examiner’s position that the specification, as well as the Wright declaration, fail to provide a quantifiable standard for which to distinguish the present claim language of “effectively continuous” and “not generally exposed” from the prior art inventions. Note the Wright Declaration states, “Understandably, one of ordinary skill in the art is readily able to optimize the spacing between rows of stitch bonded yarns, as based upon yarn density, for a particular application to provide the effectively continuous yarn face(s) of the fabric, such stitched yarn face not allowing the felt web surface to be generally exposed upon close inspection.” (Declaration, page 4, lines 9-12). While Wright’s statement may be true, it is not necessarily applicable to the present invention since the specification does not even disclose a suitable yarn density for which to base said optimization on. In other words, the specification provides no quantifiable standard for stitch yarn deniers or diameters, stitch sizes, or stitch densities, any of which would enable one of ordinary skill in the art to optimize other factors to produce an “effectively continuous” yarn face. Therefore, applicant’s arguments are found unpersuasive and the above rejections stand.



Art Unit: 1794

30. Regarding Wright's comments and applicant's arguments on the prior art of Sternlieb and Lefkowitz (Declaration, paragraph spanning pages 4-5 and Response, page 25, 1<sup>st</sup> paragraph) and page 26, 2<sup>nd</sup> paragraph), it is asserted that the Figures of the references are obviously not to scale. In other words, the drawings are enlarged so that one cannot positively determine from said drawings the coverage of the stitchbond face yarns in reality. Additionally, it is asserted that a mere change in yarn denier or stitch density, which is within the teachings of said references, would modify the proportion of yarn coverage on the face. As such, one cannot rely upon the drawings for determining coverage of the stitchbond yarns. Wright also argues that Lefkowitz's invention could not function as a filter if the yarn face was effectively continuous (Declaration, paragraph spanning pages 4-5 and Response, page 26, 2<sup>nd</sup> paragraph). This argument is unpersuasive since the term "effectively continuous" is not synonymous with impermeable.

31. In summary, it is argued that the claims are rejected over the cited prior art references in that said references read on the limitation "wherein each yarn face is effectively continuous such that the corresponding web surface is not generally exposed at the associated yarn face." Specifically, it is believed that the stitchbond stitches of said prior art are of such size, configuration, and density that they form an "effectively continuous" yarn face with a web surface that is "not generally exposed" at the surface of the stitchbonded facing fabric.

32. Regarding the definition of "felt web," applicant and the Wright Declaration assert the examiner has applied an overly broad misinterpretation of the term (Response, paragraph spanning pages 22-23 and Declaration, section 12). In response, the examiner agrees that in the absence of an explicit definition in the specification, the term must be interpreted as broadly as reasonably possible. In light of this standard for interpretation of claim language, the examiner clearly and explicitly set forth in section 7, page 4 of the very first Office Action, mailed September 22, 2000, a broad interpretation of the term that was used during prosecution. . Applicant's lack of a challenge for said interpretation during the five plus years of prosecution has been taken as a concession. Additionally, it is noted that the Board of Patent Appeals and Interferences in the Remand dated December 18, 2002, interpreted the term "felt web" even broader to include the wet formed cellulosic fiber web (i.e., tissue paper product rather than a nonwoven fabric). Thus, applicant's arguments with respect to the term "felt web" are not persuasive since the prosecution history has limited said term to the broad interpretation

Art Unit: 1794

previously set forth (i.e., any nonwoven, web, or batting comprising discontinuous or staple fibers). Hence, applicant's traversal that the prior art does not teach the newly asserted definition of "felt web" (Response, pages 24 – 27) is found unpersuasive and the rejections stand.

33. Regarding the 103 rejections, applicant reiterates the arguments relied upon to traverse the anticipation rejections. Said arguments have been addressed above. Applicant also argues that the secondary references of Kyle and Taylor do not teach the presently claimed effectively continuous yarn face (Response, pages 28-31). In response, it is asserted that the Kyle and Taylor need not contain such a teaching since said secondary references are relied upon merely for their teachings of needlepunched nonwovens and barrier layers, respectively. Therefore, applicant's arguments are found unpersuasive.

### ***Conclusion***

34. Any inquiry concerning this communication or earlier communications from the

Art Unit: 1794

examiner should be directed to Cheryl Juska whose telephone number is 571-272-1477. The examiner can normally be reached on Monday-Friday 10am-6pm. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, D. Lawrence Tarazano can be reached at 571-272-1515. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

35. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

*/Cheryl Juska/*  
Primary Examiner  
Art Unit 1794

cj  
September 10, 2009